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January 12, 2001

Board of Patent Appeals and Interferences  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Re: **Serial No.:** 09/086,857  
**Appellants:** Frederick, et al.  
**For:** System For Tracking and Dispensing  
Medical Items From Environmentally  
Controlled Storage Area  
**Docket No.:** D-1093

Sir:

Please find enclosed the Brief of Appellants Pursuant to 37 C.F.R. § 1.192, in triplicate, for filing in the above-referenced case.

Please charge the fee due upon the filing of the Brief (\$310) and any other fee that may be due, to Deposit Account No. 04-1077 (Diebold, Incorporated).

Very truly yours,



Ralph E. Jocke

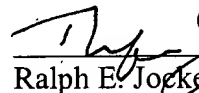
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: <b>David T. Frederick, et al.</b>	)	
	)	
Serial No.: <b>09/086,857</b>	)	Art Unit 3651
	)	
Filed: <b>May 29, 1998</b>	)	Patent Examiner:
	)	Michael E. Butler
Title: <b>System For Tracking And Dispensing</b>	)	
<b>Medical Items From Environmentally</b>	)	
<b>Controlled Storage Area</b>	)	

Board of Patent Appeals and Interferences  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby submit their Brief pursuant to 37 C.F.R. § 1.192, in triplicate,  
concerning the above-referenced Application.

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## **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

## **RELATED APPEALS AND INTERFERENCES**

Appellants believe that there are no related appeals or interferences pertaining to this matter. Nevertheless, a claim 45 rejection may be related to Appeal A992631, as noted in the Advisory Action dated November 7, 2000.

## **STATUS OF CLAIMS**

Claims 1-47 are pending in the Application.

Claims 4-23 and 27-44 have been withdrawn from consideration. Claims 1-3, 24-26, and 45-47 have been rejected on art.

Claims 1, 3, and 24-25 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne et al. ("Lavigne"). It is noted that the rejection of claims 45 and 47 was overcome by the Declaration as indicated in the Advisory Action.

Claims 1 and 24 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson, Jr. et al. 5,520,450 ("Colson '450").

Claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Pearson 5,562,232 ("Pearson '232").

Claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as anticipated by Colson, Jr. et al. 5,346,297 ("Colson '297").

Claims 1-3 and 24-26 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne.

Claim 45-46 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '297.

Claims 1, 3, and 24-26 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Aten et al. ("Aten"). It is noted that the rejection of claims 45 and 47 was overcome by the Declaration as indicated in the Advisory Action.

Claims 1-3 and 24-25 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Lavigne.

Claims 45-47 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Blechl et al. ("Blechl") in view of Weinberger.

Claim 45-47 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '297 in view of Lavigne.

These rejections were the only rejections presented in the Office Action ("Action"), which was a Final rejection dated August 16, 2000. Appellants appeal each claim rejection, inclusive.

It is noted that the rejection of claims 45-46 pursuant to 35 U.S.C. § 102(e) as anticipated by Higham et al. ("Higham") was overcome by the Declaration as indicated in the Advisory Action.

It is further noted that the rejection of claims 45-47 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Higham was overcome by the Declaration as indicated in the Advisory Action.

## **STATUS OF AMENDMENTS**

A final rejection was made August 16, 2000. An amendment and a Declaration were filed (September 27, 2000) by Appellants and were entered by the Office after the final rejection. The after final amendment and the Declaration were effective in overcoming some of the rejections presented in the Action, as discussed in more detail hereinafter.

Furthermore, a Petition for Withdrawal of a Restriction Requirement was filed by Appellants on October 10, 2000. As of the writing of this Brief, Appellants had not yet received a response by the Office in regard to their Petition. Appellants reserve all rights regarding the Office's response to the Petition, including the filing of a Supplemental Appeal Brief.

## **SUMMARY OF INVENTION**

### Overview of the Invention

An exemplary embodiment of the invention is directed to a system for providing medical items. The system may be used in dispensing and tracking an inventory of medical items stored in refrigerated or other environmentally controlled storage. The medical items may be used to treat patients in a hospital, clinic, or other healthcare setting. An overview of the system is shown schematically in Figure 13.

The system may include a computer (84) which is in operative connection with a data store (85). The data store includes user data representative of a plurality of authorized users. The data store also includes item data representative of a plurality of medical items, and location data representative of storage locations in which medical items are stored. A user interface may be in operative connection with the computer. A plurality of user interfaces are provided in this exemplary embodiment by data terminals (76, 98, 102) each of which include at least one input device such as a touch screen (78) or a card reader (80.)

The system may include a housing for storing medical items, such as a refrigerator (450), with a door (454). The door controls access to an interior area of the refrigerator. The interior area includes a storage location for at least one medical item. A lock module (452) may be attached to the refrigerator. The lock module may be in operative connection with the computer. The lock module may operate in response to at least one signal from the computer to change the condition of the lock module from a locked to an unlocked condition.

In response to a user inputting identification data through the input device, which identification data corresponds to that of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the input device. The computer is operative responsive to the input of the item indicia, corresponding to a medical item stored in the interior area, to provide a signal changing the lock module to the unlocked condition. This enables the door to be opened and the medical item in the storage location to be accessed by the authorized user.

## **CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW**

The questions presented in this appeal are:

- 1). Whether Appellants' claims 1, 3, and 24-25 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Lavigne.
- 2). Whether Appellants' claims 1 and 24 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '450.
- 3). Whether Appellants' claim 45 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Pearson '232.
- 4). Whether Appellants' claim 45 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '297.
- 5). Whether Appellants' claims 1-3 and 24-26 are unpatentable under 35 U.S.C. § 103(a) over Lavigne.
- 6). Whether Appellants' claims 45-46 are unpatentable under 35 U.S.C. § 103(a) over Colson '297.
- 7). Whether Appellants' claims 1, 3, and 24-26 are unpatentable under 35 U.S.C. § 103(a) over Lavigne in view of Aten.
- 8). Whether Appellants' claims 1-3 and 24-25 are unpatentable under 35 U.S.C. § 103(a) over Colson '450 in view of Lavigne.
- 9). Whether Appellants' claims 45-47 are unpatentable under 35 U.S.C. § 103(a) over Blechl in view of Weinberger.

- 10). Whether Appellants' claims 45-47 are unpatentable under 35 U.S.C. § 103(a) over Colson '297 in view of Lavigne.

## **GROUPING OF CLAIMS**

No groups of claims stand or fall together. Each of Appellant's claims 1-3, 24-26, and 45-47 recite at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claim.

Every claim recites additional features of the invention which patentably distinguishes the claim over every other pending claim.

The pending claims include three independent claims (claims 1, 24, and 45). Claims 2-3 depend from claim 1. Claims 25-26 depend from claim 24. Claims 46-47 depend from claim 45.

The claims involved in this appeal are reproduced in the Appendix.

## **ARGUMENT**

### **The Applicable Legal Standards**

Anticipation pursuant to 35 U.S.C. § 102(b) requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102(b) requires in a single prior art disclosure, each and every element of the claimed invention in a manner such that the reference would literally



infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish *prima facie obviousness*, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

### **The Lavigne Reference**

Lavigne discloses a carrier for holding and transporting medical items. It is designed to be carried by a medical technician or other person and to allow them to track their activity in removing medical items from the carrier. The enclosure of Lavigne includes an opening (49)

with a hinged door (21) which can be moved to cover or uncover the opening (Col. 4, line 65-Col. 5, line 2). Within the enclosure is a drawer (41). The drawer is used to hold controlled substances. To open the drawer the operator must insert a key into a key lock (42) (Col. 4, lines 41-45).

A carrier includes a controller (79) which monitors the temperature of drugs inside the carrier to be sure that temperature sensitive drugs therein are maintained within their proper temperature range. The controller also operates to record temperature conditions, as well as information concerning the identity of the person having custody of the carrier and events such as the opening of the door to access the medications in the carrier (Col. 7, lines 53-Col. 8, line 3; Col. 9, lines 6-16). In this way activities by the person in possession of the carrier as well as temperature events are recorded over a period of time.

In operation of the device of Lavigne, when an operator takes control of the carrier the operator inserts a data key into a reader (73). This data is stored to indicate the person who has possession of the carrier (Col. 14, lines 20-27). When the person in control of the carrier wishes to administer a drug, they can open the door (21), remove the desired drug from the carrier and administer the drug to the patient. The operator also records the administration of the drug by entering a code into memory (Col. 14, lines 34-43).

The controller in the Lavigne carrier monitors the temperature of the temperature sensitive medications held therein. If the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) to hold it in a closed position (Col. 11, lines 37-43). This alerts the user to the fact that the drugs in the carrier may

have been subject to spoilage due to an out of temperature condition. However a user is enabled to open the door (21) through a mechanical override if the user needs to obtain access to the medications even when there has been an out of temperature condition (Col. 12, line 64-Col. 13, line 2). Thus, the door (21) which controls access to the medical items in the carrier is always open and accessible except when the door is locked due to the occurrence of an out of temperature condition.

#### **The Colson '450 Reference**

Colson '450 discloses a cabinet system for holding items therein. Colson has a cabinet (1) with dividers which form cavities. One such subcavity (19) includes a computer (21). The computer is described as including a keyboard (23) and optionally a display means, a mouse device, and an output device such as a printer.

One of the cavities in the cabinet includes a refrigerator (101) for holding medicines which require lower storage temperatures. The various compartments, including the compartment holding the refrigerator are covered by doors (25). The doors can be opened to access the cavities. Each of the doors has associated therewith a locking/unlocking means (37). The locking means includes a solenoid to control the unlocking thereof.

When a user wishes to access items in a cavity behind one of the doors, the user inputs to the computer keyboard (23) information concerning the particular patient and information as to the person entering the data. The computer then causes electrical impulses to

be issued that travel to a particular electric solenoid to unlock a particular door and permit access to the interior area of the cabinet behind the unlocked door (Col. 5, lines 17-27).

### **The Pearson '232 Reference**

The reference to Pearson '232 is directed to an apparatus for dispensing medication. The apparatus includes a movable cart (2). The cart includes containers (8) and drawers (10) for holding medications. A suction tube (12), which is handled and operated by a nurse, is used to dispense pills and tablets from the containers (8). The nurse may also manually dispense other medication items (e.g., cream, syringe) from a drawer (10). A computer (14) has an input device such as a keyboard. The computer controls locking of the containers (8) and drawers (10), and monitors operation of the suction tube (12). After medications are loaded into the dispenser, the computer controls access to the individual compartments. The computer may correlate the time and a patient's identity to the dosages of each pill appropriate for that patient at that time in accordance with medication orders.

A nurse may input patient information and physician orders into the computer. The computer then compiles a list of medications needed for a selected period of time. A pharmacist reviews the list and loads the proper quantities of medications into the proper containers and drawers. After the pharmacist confirms to the computer that each medication has been properly loaded, then the cart is ready to be used by a nurse to dispense medications to multiple patients.

During dispenser operations the cart may be rolled to several different patient locations. A nurse enters a password to be authorized to use the medication dispenser. The nurse also

inputs patient identifying information. The computer unlocks each appropriate container (8) or drawer (10) which holds medication which that particular patient is scheduled to receive at that time. A signal light (22) for each unlocked container (8) or drawer (10) may be changed to green, making it easy for the nurse to identify the proper medication compartment. If the medication is in one of the containers (8), then the nurse uses the suction tube (12) to withdraw the medication. If the medication is in one of the drawers (10), then the nurse manually withdraws the needed item.

#### **The Colson '297 Reference**

The reference to Colson '297 is directed to an auxiliary storage and dispensing unit. The unit is for use in connection with a supply and medication dispenser station. In operation, information concerning the needed patient item and the entering party, inputted into a keyboard (65) results in a cabinet door (19) being unlocked (Col. 4, lines 39-53). Lamps (109) are located in the interior of the cabinet (3). The electric lighting provides illumination to help a user locate stored items (Col. 6, lines 57-68).

#### **The Aten Reference**

The reference to Aten is directed to a controlled dispensing device for use by a drug therapist. A field unit is loaded with medication containers in a predetermined sequence. A program of dosing times is stored in a memory of the field unit. The field unit permits dispensing of containers only in accordance with the predefined schedule.

### **The Blechl Reference**

The reference to Blechl is directed to a drug dispenser device (10). As shown in Figure 1, the dispenser device includes a drawer (28) which provides access to the dispensed medicines. When a user designates a type and quantity of desired medications into the input unit (248) of the control device (300), the medications drop from their cartridges (90) into the drawer (28). The input unit may include a user interface screen (30) having touch sensitive features in communication with a microprocessing means (26). The top of the device (10) is provided with a medication access door (40) permitting a designated individual to stock the device.

As shown in Figure 2, the device (10) includes a medication storage area. A printed circuit board (50) has apertures (52, 54) allowing free fall of drug containers to the drawer (28). The board (50) includes female electrical connectors (56). Figures 3, 4, and 11 show a dispenser (60) made to be inserted into the medication storage area. Offset from the bottom of the dispenser (60) is a support lip (76) which rests against the printed circuit board (50) to support the dispenser (60). Extending downward from the support lip (76) is a male electrical connector (78) adapted to connect with a female electrical connector (56). A solenoid (68) is provided on the exterior of the dispenser housing (62). The solenoid (68) includes a piston (70) which is operatively connected to rotating linkage (72) which is contained on a pivot rod (74). The pivot rod (74) is secured to an arm (82) having a stepped portion (84). Actuation of the solenoid (68) causes rotation of pivot rod (74). Note Figures 10, 15, 17, and 18.

Figures 5-9 show a cartridge (90) for insertion into the dispenser (60). The cartridge (90) is sized to slide into the interior space (64) of the dispenser (60). Stacked medication containers

(108) are contained in the interior storage space (102) of the cartridge (90). A retaining member (110) prevents the medication containers (108) from falling out the open bottom (100) of the cartridge (90).

Upon insertion of the cartridge (90) into the dispenser (60), the user removes the retaining member (110) allowing free fall of the medication containers (108) to a dispensing platform (86) of the dispenser (60). The dispensing platform (86) has an aperture (88). Upon actuation of the solenoid (68), the stepped portion (84) urges the medication container (108) resting on the dispensing platform (86) out the aperture (88) where gravity induces it to fall to the drawer (28).

#### **The Weinberger Reference**

The reference to Weinberger is directed to a programmable medication dispensing system. The system is used by self-administering patients such as home-care patients. The system includes a prescribing data entry station for use by a physician. The physician operates the data entry station to store prescription information in a portable prescribing module. The system also includes a dispensing data entry station for use by a pharmacist. The pharmacist stores dispensing information in a portable dispensing data storage module. The system includes a medication dispenser which accepts the portable modules. The dispenser operates in response to the information in the dispensing data storage module to remind the patient to take their medications and to make the medications available to the patient. The information stored in the prescribing module is used to instruct the patient on use of medication in the dispenser in accordance with the information input by the physician.

**Lavigne, Colson '450, Pearson '232, and Higham, Do Not Constitute Prior Art**

The present application is a continuation-in-part (CIP) application of application 08/927,593 filed September 11, 1997. Application 08/927,593 is a CIP application of application 08/361,783 (now Patent 5,790,409) filed December 16, 1994. In addition, numerous elements of pending claims are disclosed in earlier applications from which this Application claims priority, including Application Serial Number 08/009,055 filed January 25, 1993 (now U.S. Patent 5,404,384) and Serial Number 08/186,285 filed January 25, 1994 (now U.S. Patent 5,533,079).

Appellants submitted a Declaration on September 27, 2000. The Declaration was entered and considered by the Office. The Declaration and attached documentation established that the invention claimed in at least present claims 24 and 45 was reduced to practice in this country prior to March 7, 1994.

It is further noted in light of MPEP § 715.02 that "Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the references. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art." Accordingly, Appellants respectfully submit that even if the Declaration and attached documentation were not fully commensurate with the rejected claims, the Office still must



consider whether Appellants had reduced to practice a novel system which would have rendered the claimed invention (claims 24 and 45) obvious to one of ordinary skill in the art.

It is noted that the Action in paragraph 18 has alleged a feature of new matter as being the “lock module mounted to the ‘exterior’ surface of the housing” (claim 24). However, as discussed above in accordance with MPEP § 715.02, even if the Declaration and attached documentation were not exactly commensurate with claim 24, the Office still must take into consideration whether Appellants still had reduced to practice a novel system which would have rendered the claimed invention of claim 24 obvious to one of ordinary skill in the art. It is respectfully submitted that the record indicates that the Office itself considers this feature to be obvious to one of ordinary skill in the art. Evidence of this fact is demonstrated by the Action’s own effort to render this feature as obvious in the Action’s 35 U.S.C. § 103(a) type rejections of claim 24. (Contrarily, if this feature is not obvious, then the Action’s 35 U.S.C. § 103(a) type rejections of claim 24 are moot.)

In conclusion, the Declaration and attached documentation effectively swore back to a date prior to March 7, 1994 for at least present claims 24 and 45. Thus, a date prior to March 7, 1994 is the critical date of at least claims 24 and 45.

Claim 45 is reproduced below to show that the recited subject matter has support in Patent 5,790,409. Claim 24 is similar in scope to claim 45. The claim 45 is reproduced having referenced column and line locations corresponding to Patent 5,790,409 inserted therein. Of course, it should be understood that these referenced locations are for discussion purposes only and that the claim is not limited to the embodiment presented. No unnecessary limitations are to

be implied from using such references in the present claim for purposes of illustration. The present invention is not limited to the details, features and relationships shown or described in the prior Patent 5,790,409 or the pending application.

Claim 45      A system for providing medical items comprising:

(Col. 3, lines 20-63) a computer (84; 86), wherein the computer is in operative connection with the data store (Col. 3, lines 22-26; Col. 10, lines 31-34), wherein the data store includes user data representative of a plurality of authorized users (Col. 3, lines 22-26; Col. 8, lines 43-58), item data representative of a plurality of medical items (Col. 3, lines 22-26; Col. 4, lines 8-12; Col. 9, lines 20-36), and location data (Col. 3, lines 22-26; Col. 9, lines 20-36) representative of storage locations in which the medical items are stored;

a user interface (Col. 3, lines 20-22; Col. 8, lines 15-17) in operative connection with the computer, wherein the interface includes at least one input device (Col. 9, lines 42-47; Col. 8, lines 15-24);

(Col. 16, lines 11-33) a housing (Col. 16, lines 17-19), wherein a storage location for at least one medical item is located in an interior area of the housing, the

housing including a door (96), wherein access to the storage location is controlled by opening and closing the door (Col. 16, lines 19-23);

a lock (Col. 16, lines 19-23) in operative connection with the housing, wherein the lock is in operative connection with the computer (Col. 16, lines 53-57, 24-33), and wherein the lock is operative responsive to at least one signal from the computer to change the lock from a locked to an unlocked condition (Col. 16, lines 53-57), wherein in the locked condition the door is prevented from being opened and in the unlocked condition the door is enabled to be opened;

wherein responsive to a user inputting through the at least one input device identification data (Col. 8, lines 28-42) corresponding to data for an authorized user stored in the data store (Col. 8, lines 28-42), the computer enables the user to input item indicia corresponding to a medical item through the at least one input device (Col. 17, lines 1-12, 49-54; Col. 8, lines 9-17; Col. 16, lines 46-57), and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition (Col. 16, lines 26-30, 54-57; Col. 17, lines 9-13).

As clearly shown by Appellants, each recited feature in claim 45 (and also claim 24) has basis in Patent 5,790,409, from which the present application claims priority. Furthermore, in view of the accepted Declaration, claim 45 (and claim 24) is entitled to a critical date prior to March 7, 1994.

**Lavigne Does Not Constitute Prior Art**

Lavigne was filed March 2, 1995. However, Appellants' entitled date (prior to March 7, 1994) is earlier than March 2, 1995. Thus, Lavigne cannot constitute prior art against at least claims 24 and 45. Furthermore, the Office has admitted (in the Advisory Action) that "The affidavit was effective in overcoming the rejections to claim 45 in view of Lavigne & Lavigne/Aten."

**Colson '450 Does Not Constitute Prior Art**

Colson '450 was granted on a CIP application of Colson '297. Colson '297 does not include the pertinent features for which Colson '450 was applied in the Action. Specifically and by way of example and without limitation, Colson '297 (explained in more detail hereinafter) does not disclose or suggest a data store including "data representative of a plurality of authorized users", or "data representative of a plurality of medical items", or "data representative of storage locations in which the medical items are stored", or the input of "identification data corresponding to data for an authorized user stored in the data store", or enabling a "user to input item indicia" in response thereto. It is respectfully submitted that Colson '297 does not disclose these features. Thus, even if it were possible for Colson '450 to have included the recited features, Colson '450 is not entitled to the filing date of Colson '297 for the recited features.

Hence, for purposes of this appeal, Colson '450 has a filing date limited to August 2, 1994. However, Appellants' entitled date (prior to March 7, 1994) is earlier than August 2, 1994. Thus, Colson '450 cannot constitute prior art against at least claims 24 and 45.

Furthermore, because Colson '297 does not disclose or suggest the recited features, it is respectfully submitted that Appellants do not need to swear behind the Colson '297 reference in order to establish patentability of the present invention.

**Pearson '232 Does Not Constitute Prior Art**

The actual filing date of the Pearson '232 reference is February 12, 1996. Pearson '232 claims priority to several earlier applications. Pearson '232 is a continuation of Pearson 5,490,610 (filed April 13, 1995), which is a continuation of abandoned Application Serial Number 206,877 (filed March 7, 1994), which is a CIP of Pearson '029.

However, it is respectfully submitted that Pearson '232 can claim a priority date no earlier than March 7, 1994, which is the filing date of Application Serial Number 206,877. This is because Application 206,877 is a CIP of Pearson 029. Thus, March 7, 1994 is the date in which Application 206,877 (and Pearson '232) relied on new subject matter (not found in Pearson '029) to support the invention therein. This new matter was critical to the issued Pearson '232. Thus, at best, March 7, 1994 is the critical reference date of Pearson '232.

As evidenced by the lack of a Pearson '029 rejection in the Action, Pearson '029 does not disclose the features that were considered pertinent to the pending claims. Specifically and by way of example and without limitation, Pearson '029 does not disclose or suggest a "data store" including "data representative of a plurality of authorized users", or the input of "identification

data corresponding to data for an authorized user stored in the data store”, or enabling a “user to input item indicia” in response thereto. There is no indication that Pearson ‘029 includes a “data store” in the manner recited. Pearson ‘029 does not disclose determining that the user is an authorized user. There is no indication that Pearson ‘029 is concerned with input of identification data corresponding to data for an authorized user stored in the data store. In Pearson ‘029 the nurse (user) merely inputs the patient’s ID into the keyboard (Col. 5, lines 16-17) during operation to obtain the medication. It is respectfully submitted that Pearson ‘029 does not disclose the recited features. Thus, even if it were possible for Pearson ‘232 to have included the recited features, Pearson ‘232 is not entitled to the filing date of Pearson ‘029 for these recited features.

For purposes of this appeal, Pearson ‘232 at best has a filing date limited to March 7, 1994. However, Appellants’ entitled date (prior to March 7, 1994) is earlier than March 7, 1994. Thus, Pearson ‘232 cannot constitute prior art against at least claims 24 and 45.

#### **Higham Does Not Constitute Prior Art**

Higham was filed July 14, 1994. However, Appellants’ entitled date (prior to March 7, 1994) is earlier than July 14, 1994. Thus, Higham cannot constitute prior art against at least claims 24 and 45. Furthermore, the Office has admitted (in the Advisory Action) that the Declaration was “effective in overcoming the 102(e) based anticipatory and obviousness rejections of claim 45 as evidenced by Higham.”

### **Numerous Rejections Are Overcome By Appellants' Prior Invention**

Appellants have established that the subject matter of at least claims 24 and 45 was reduced to practice in this country prior to at least March 7, 1994. As a result many of the rejections (involving at least claims 24 and 45) presented in the Action which are based on 35 U.S.C. § 102 are obviated. The paragraphs referenced below correspond to those presented in the Action. These obviated rejections (involving claims 24 and 45) include:

Rejections based on Lavigne (Paragraph 5)

Rejections based on Colson '450 (Paragraph 6)

Rejections based on Pearson '232 (Paragraph 7)

Rejections based on Higham (Paragraph 8)

Furthermore, the Patent Office Rules also provide that when an obviousness rejection is based on one or more references and the applicant swears behind one reference, the obviousness rejection is overcome. MPEP § 715.02. As a result the following rejections (involving at least claims 24 and 45) in the Action pursuant to 35 U.S.C. § 103 are obviated because Appellants have sworn behind at least one of the references. These obviated rejections are as follows:

Lavigne alone (Paragraph 11)

Higham alone (Paragraph 12)

Lavigne and Aten (Paragraph 14)

Colson '450 in view of Lavigne (Paragraph 15)

Colson '297 and Lavigne (Paragraph 17)

Since many of the applied references do not constitute prior art in relation to at least claims 24 and 45, it is respectfully submitted that the only questions remaining in this appeal are:

- 1). Whether Appellants' claims 1 and 3 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Lavigne.
- 2). Whether Appellants' claim 1 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '450.
- 3). Whether Appellants' claim 45 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '297.
- 4). Whether Appellants' claims 1-3 are unpatentable under 35 U.S.C. § 103(a) over Lavigne.
- 5). Whether Appellants' claims 45-46 are unpatentable under 35 U.S.C. § 103(a) over Colson '297.
- 6). Whether Appellants' claims 1 and 3 are unpatentable under 35 U.S.C. § 103(a) over Lavigne in view of Aten.
- 7). Whether Appellants' claims 1-3 are unpatentable under 35 U.S.C. § 103(a) over Colson '450 in view of Lavigne.
- 8). Whether Appellants' claims 45-47 are unpatentable under 35 U.S.C. § 103(a) over Blechl in view of Weinberger.

Furthermore, it is noted that the Advisory Action indicated that the rejections involving either Higham or Lavigne in relation to claims 45-47 were overcome by the Declaration. Hence, the rejection of claims 45-46 pursuant to 35 U.S.C. § 102(e) as anticipated by Higham was



overcome. Furthermore, the rejection of claims 45-47 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Higham was overcome. Furthermore, the rejection of claims 45-47 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '297 in view of Lavigne was overcome.

**(iii) 35 U.S.C. § 102**

Appellants' arguments against the prior art rejections are based on the Office's interpretation of the references as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the references by the Office would constitute a new ground of rejection.

**The Pending Claims Are Not Anticipated By Lavigne**

Claims 1 and 3 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne.

These rejections are respectfully traversed. Appellants traverse these rejections on the grounds that the Lavigne reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claims patentably distinguish over the Lavigne reference.

**Claim 1**

Claim 1 is an independent claim which is specifically directed to a "system for providing medical items." The claim specifically recites that "the lock module is operative responsive to a signal from the computer to change the lock module from a locked to an unlocked condition."

The claim further recites that “the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition.”

Appellants respectfully submit that Lavigne does not disclose the recited features and relationships. The Action alleges that Lavigne discloses a “lock responsive to the computer (col. 11 L 39-43)”; “the computer operative to output a signal which changes the lock (col. 11, L 39-43; col. 8, L 59-62)”; and that the “computer is operative responsive to input of the item indicia to unlock the module (col. 8, L 24-30; col. 8 L 58-59).” The Appellants disagree.

In Lavigne, when the person in control of the carrier wishes to administer a drug, they can open the door (21), open a drawer (37, 41, 43), remove the desired drug from the carrier, and then administer the drug to the patient (Col. 14, lines 34-45). The operator also records the administration of the drug by entering a code into memory. The controller in the Lavigne carrier monitors the temperature of the temperature sensitive medications held therein. If the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) and hold it in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). This alerts the user to the fact that the drugs in the carrier may have been subject to spoilage due to an out of temperature condition. An out of temperature condition (e.g., locked door 21) typically can only be cleared by the use of a pharmacist key (Col. 12, lines 60-63) which also resets the controls (Col. 11, lines 3-12). However, a user is enabled to open the door (21) through a mechanical override if the user needs to obtain access to the medications even when there has been an out of temperature condition (Col. 12, line 64-Col. 13, line 2).

Appellants respectfully submit that Lavigne does not disclose using a computer to change a lock module from a locked to an unlocked condition. Lavigne, at best, is only capable of locking the door (21). The door is unlocked by use of a pharmacist key. Hence, Lavigne does not disclose using a computer to unlock a lock module.

Appellants respectfully submit that Lavigne also does not disclose a computer operative responsive to an input of an item indicia to output a signal changing the lock module to the unlocked condition. Lavigne does not disclose using a computer, which responds to inputted data, to output a signal to change a lock module from a locked condition to an unlocked condition. In Lavigne, the door (21) is unlocked by use of a pharmacist key, not by a computer. It follows that Lavigne's door (21) is not unlocked by a computer in response to inputted data.

Furthermore, nothing in Lavigne compares identification information input by a user to data stored in a data store. The memory on the Lavigne carrier holds information corresponding to the person having possession of the carrier at any given time. However there is no disclosure or suggestion in Lavigne that the information input concerning the person having custody of the carrier is compared to a listing of "authorized users."

Claim 1 further specifically recites that responsive to the input of identification data corresponding to an authorized user, a user is enabled to input data corresponding to a medical item. Again nothing in Lavigne discloses or suggests that a user is enabled to input indicia corresponding to a medical item responsive to the input of information corresponding to an authorized user in a database.

Additionally claim 1 specifically recites that responsive to the input of the medical item indicia (which activity is enabled when the identification data input corresponds to an authorized user), the computer is caused to output a signal, which signal changes the lock module controlling the door of the refrigerator to an unlocked condition. Nothing in Lavigne discloses or suggests controlling a lock to open the door (21) in response to either medical item indicia or identification data corresponding to an authorized user. As Lavigne makes amply clear, the door (21) of his medication carrier is always unlocked except in circumstances when an out of range temperature condition has been sensed, in which case the door will lock because a temperature violation which could have damaged the medications has occurred (see Col. 11, lines 37-43).

It is respectfully submitted that claim 1 recites numerous features and relationships which are neither disclosed nor suggested in Lavigne. Thus, Lavigne does not anticipate the claim. For these reasons it is respectfully submitted that claim 1 as well as all the claims that depend therefrom (including any claims that are currently withdrawn from consideration) should be allowed.

### **Claim 3**

Claim 3 depends from claim 1 and further recites that “the lock module further comprises a door sensor, wherein the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock module to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.”

Appellants respectfully submit that Lavigne does not disclose a computer operative responsive to an open door signal to change a lock module to a locked condition. In Lavigne, if the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). That is, the controller of Lavigne operates the locking solenoid (139) based on sensing temperature conditions, not on sensing whether the door was opened. In Lavigne the door (21) may be opened many times without initiating the locking solenoid (139) (Col. 9, lines 7-10; Col. 14, lines 34-37; Col. 12, lines 15-18).

The Lavigne system senses the opening of a door to record an event in memory. However, the sensing of the door opening in no way causes a lock to change its condition so that when the door of the Lavigne carrier is thereafter closed, it is held closed and locked. The portion of the Lavigne reference cited against claim 3 in the Action (Col. 6, lines 47-56) only indicates that sensors are included for sensing when drawers of the Lavigne carrier have been opened. Nothing in Lavigne discloses or suggests that in response to sensing the opening of a drawer, a lock condition is changed so that the door will be locked the next time it is closed, as is specifically recited in claim 3.

Lavigne does not disclose each and every feature and relationship of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Thus, Lavigne does not anticipate the claim. Hence, Appellants' claim 3 patentably distinguishes over the Lavigne reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection should be withdrawn.

### **The Pending Claims Are Not Anticipated By Colson '450**

Claim 1 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson '450.

This rejection is respectfully traversed. Appellants traverse this rejection on the grounds that the Colson '450 reference does not contain all the elements of the claimed invention arranged in the manner recited in the claim. The features recited in Appellants' claim patentably distinguish over the Colson '450 reference.

#### **Claim 1**

Claim 1 is an independent claim which is specifically directed to a "system for providing medical items." The claim specifically recites that "the data store includes user data representative of a plurality of authorized users." The claim further recites that "responsive to a user inputting identification data through the input device of the interface corresponding to the data representative of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to the one medical item through the input device." The claim further recites that "the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition."

Appellants respectfully submit that Colson '450 does not disclose the recited features and relationships. The Action alleges that Colson '450 discloses that a "data store includes user data representative of a plurality of authorized users (col. 5, L 17-29; Fig. 1. #21)." The Appellants disagree. The referenced section is not pertinent to a data store having user data representative of a plurality of authorized users. In the cited section of Colson '450, the user inputs "information concerning the particular patient and information as to the person entering the data" (Col. 5, lines

17-19). The patient's record (reflecting the inputted patient information and the user, e.g., the particular nurse) may be simultaneously and automatically updated (Col. 5, lines 20-29). Information may even be processed in real-time (Col. 3, lines 45-57). However, there is no indication that Colson '450 is concerned with the user being an authorized user.

Colson does not state that any comparison is made of the information that is input as to the person entering the data, to any data concerning authorized users, or to any data stored in a data store. The operation of Colson merely specifies that information is input, the door is unlocked, and records are updated.

Appellants respectfully submit that Colson '450 does not disclose the capability of inputting identification data through an input device corresponding to the data representative of an authorized user stored in a data store. Colson '450 does not use data representative of an authorized user. Colson '450 does not use data representative of an authorized user stored in a data store.

Furthermore, Colson '450 does not disclose that in response to a user inputting identification data corresponding to an authorized user, the computer enables the user to input data corresponding to a medical item through the input device. Colson '450 does not disclose the capability of checking whether a user is an authorized user. Colson '450 does not disclose enabling the input of data corresponding to a medical item, in response to the user inputted identification data corresponding to an authorized user data.

Additionally, as previously discussed, the user in Colson '450 inputs "information concerning the particular patient and information as to the person entering the data" (Col. 5, lines

17-19). Hence, it appears that the user in Colson '450 actually inputs the "information concerning the particular patient" prior to inputting the "information as to the person entering the data." This is further evidence that Colson '450 is not concerned with the user being an authorized user. Additionally, the use of the inputted user information appears to be only for the patient's record, e.g., the nurse that supplied the medication.

Again, there is no disclosure or suggestion whatsoever in Colson '450 that Colson '450 has a computer in connection with a data store with authorized user data, data representative of medical items, and data corresponding to storage locations where medical items are stored. Further nothing in Colson '450 discloses or suggests that a user inputs identification data to an input device, and that the input data is compared to data representative of authorized users. As Colson '450 expressly indicates (Col. 5, lines 17-29), a user of the Colson '450 device inputs information concerning a patient and information on the person entering the data, and the door opens. There is no teaching, suggestion, or motivation in Colson '450 that a comparison is made of input user identification data to data concerning a plurality of authorized users.

Claim 1 also specifically recites that the computer enables a user to input indicia corresponding to a medical item through an input device. As Colson '450 expressly indicates (Col. 5, lines 17-29), no item indicia corresponding to a medical item is input into the Colson '450 computer. Colson '450 only inputs information concerning a patient and the person entering the data, which then causes a door to open. Nothing in Colson '450 discloses or suggests the feature of a computer enabling a user to input indicia corresponding to a medical item through an input device, which is specifically recited in claim 1.



Claim 1 further recites that the computer is operative responsive to input of the item indicia corresponding to a medical item, to output a signal changing a lock from a locked to an unlocked condition, enabling opening a door of the refrigerator. Again, Colson '450 does not disclose or suggest the input of indicia corresponding to a medical item through an input device, nor having such input data cause a computer to unlock a lock.

It is respectfully submitted that claim 1 recites numerous features and relationships which are neither disclosed nor suggested in Colson '450. Thus, Colson '450 does not anticipate the claim. For these reasons it is respectfully submitted that claim 1 as well as all the claims that depend therefrom (including any claims that are currently withdrawn from consideration) should be allowed.

### **The Pending Claims Are Not Anticipated By Colson '297**

Claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson '297.

This rejection is respectfully traversed. Appellants traverse this rejection on the grounds that the Colson '297 reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claim patentably distinguish over the Colson '297 reference.

### **Claim 45**

Claim 45 is an independent claim which is specifically directed to a "system for providing medical items." The claim specifically recites that "the computer is in operative connection with

the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored.” The claim further recites that “responsive to a user inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the at least one input device, and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition.”

It is respectfully submitted that claim 45 recites features and relationships that are plainly not found in Colson '297. In contrast to the elements recited in claim 45, the system in Colson '297 does not disclose a computer with a data store having stored user information corresponding to “authorized users.” Further, Colson '297 does not have a computer that operates responsive to the input of data that corresponds to one of the authorized users, to enable input of indicia which identifies a medical item. Colson '297 operates in the manner expressly indicated therein (e.g., Col. 4, lines 39-52). Inputs through a keyboard identifying a medical item and identifying a person cause a door to unlock. There is no disclosure or suggestion of comparing the input concerning the person taking the item, to data in a data store containing data for a plurality of authorized users. Colson '297 simply receives the data and apparently stores the data for later recovery. There is no ability to compare input data to previously stored data, as expressly recited in the claim.

Further there is no disclosure in Colson '297 of the feature that a computer operates in response to determining that the input user data corresponds to one of the authorized users, to then enable input of indicia identifying a medical item. According to Colson '297, identifying information concerning a medical item can be input at any time and is apparently input before any user information (Col. 4, lines 39-52). Colson '297 further fails to disclose or suggest this feature which is expressly recited in claim 45.

Claim 45 also recites that the data store in operative connection with the computer includes location data representative of storage locations in which medical items are stored. The cited portions of Colson '297 do not disclose a data store, nor a data store including location data representative of storage locations in which particular medical items are stored. Further Colson '297 does not disclose the relationship as specifically recited in claim 45, that the computer operates to enable the input of item indicia corresponding to a medical item responsive to receipt of identifying data corresponding to data for an authorized user among a plurality of authorized users for whom data is stored, and the computer then operating responsive to the item indicia to generate a signal changing the condition of the lock to an open condition.

It is respectfully submitted that claim 45 recites numerous features and relationships which are neither disclosed nor suggested in Colson '297. Thus, Colson '297 does not anticipate the claim. For these reasons it is respectfully submitted that claim 45 as well as all the claims that depend therefrom should be allowed.

**(iv) 35 U.S.C. § 103**

Appellants' arguments against the prior art rejections are based on the Office's interpretation of the references as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the references by the Office would constitute a new ground of rejection.

**The Pending Claims Are Not Obvious Over Lavigne**

Claims 1-3 were rejected under 35 U.S.C. § 103(a) as obvious over Lavigne. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied reference.

**Claims 1 and 3**

As previously discussed, claims 1 and 3 recite numerous features and relationships that are not found in Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. The rejection on the basis of Lavigne alone does not overcome the deficiencies of the rejections already discussed, which rejections assert that the pending claims 1 and 3 are anticipated by the same reference. As the reference does not disclose or suggest all the

elements of the claims (nor any teaching, suggestion, or motivation to produce the claimed combination), the rejection is further respectfully submitted to be improper on this basis.

Appellants' remarks, concerning the anticipation of claims 1 and 3 by the Lavigne reference, are herein incorporated by reference.

### Claim 2

Claim 2 depends from claim 1 and further recites that "the lock module further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the signal that the door is enabled to be opened."

The Action alleges that Lavigne shows a visual indicator proximate the lock (Col. 11, lines 3-43). Hence, the Action inherently admits that Lavigne lacks a lock module comprising a visual indicator. The Action alleges that it would have been obvious to place a visual indicator on Lavigne's lock. Appellants disagree.

Appellants respectfully submit that Lavigne does not disclose a lock module comprising a visual indicator. In Lavigne, at best it is the control module (31) which has a visual indicator (LEDs 75) (Col. 5, lines 54-57), not a lock module.

Also, the Action has not shown any reason or motivation to combine, or explained how or why a visual indicator would be placed on Lavigne's locking arrangement (solenoid 139) as alleged. Especially when the control module (31) already has a visual indicator. Thus, any attempt to dramatically change the structural arrangement of Lavigne would go directly against the implicit teaching of the Lavigne reference and would destroy the reference. That is, the alleged modification to Lavigne would destroy the disclosed utility or operability of the Lavigne

teaching. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, it would not have been obvious to have provided Lavigne with a visual indicator in the manner recited.

Furthermore, claim 2 specifically recites that the visual indicator provides an indication that the door is enabled to be opened. In Lavigne, the indicator lights (LEDs 75) only indicate a temperature condition (Col. 11, lines 25-43), not the door's opening condition. For example, if a temperature violation has occurred for the temperature sensitive items in the drawers (37) then the door (21) will lock (Col. 11, lines 37-41). However, if the temperature violation has occurred in the refrigerated drawer (47) then the door (21) can still be opened (Col. 11, lines 41-43). Hence, it appears that upon an occurrence of a temperature violation one would be unable to determine from the LED whether the door (21) is enabled to be opened. Any attempt to modify Lavigne to include a lock module comprising a visual indicator to provide an indication that a door is enabled to be opened is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is impermissible. Thus, Lavigne does not disclose or suggest a visual indicator for providing an indication that a door is enabled to be opened.

Furthermore, claim 2 recites that "the visual indicator provides an indication responsive to the signal that the door is enabled to be opened." From claim 1, the "signal" is from a computer to change the lock module from a locked to an unlocked condition. Lavigne does not disclose or suggest that a visual indicator is responsive to a signal (from a computer) to change a

lock module from a locked to an unlocked condition. Contrarily, as previously discussed, Lavigne, at best, only discloses changing a locking solenoid (139) from an unlocked to a locked condition. Thus, Lavigne actually teaches away from the subject matter recited in claim 2.

It is respectfully submitted that the rejection on the basis of Lavigne should be withdrawn as it fails to establish that all the features recited in Appellants' claim are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

#### **The Pending Claims Are Not Obvious Over Colson '297**

Claims 45-46 were rejected under 35 U.S.C. § 103(a) as obvious over Colson '297. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied reference.

#### **Claim 45**

As previously discussed, claim 45 recites numerous features and relationships that are not found in Colson '297. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claim is at least known in the prior art. MPEP § 2142. The rejection on the basis of Colson '297 alone does not overcome the deficiencies of the rejections already discussed, which rejections assert that the pending claim 45

is anticipated by the same reference. Thus, as the reference does not disclose or suggest all the elements of the claims (nor any teaching, suggestion, or motivation to produce the claimed combination), the rejection is further respectfully submitted to be improper on this basis.

Appellants' remarks, concerning the anticipation of claim 45 by the Colson '297 reference, are herein incorporated by reference.

#### **Claim 46**

Claim 46 depends from claim 45 and further recites that "the lock further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the at least one signal that the door is enabled to be opened."

The Action alleges that Colson '297 shows that a "lock comprises a visual indicator illuminating the region of the store medication item (col. 3, L 10-16)." The Action then alleges that it would have been obvious to "modify the illumination to a visual indicator on released lock." Appellants disagree.

Appellants respectfully submit that Colson '297 does not disclose a lock comprising a visual indicator. The Action's cited section of Colson '297 (Col. 3, lines 10-16) refers to electric lighting which is further discussed at Col. 6, lines 57-68. Colson '297 does not disclose a lock comprising the electric lighting. Instead the electric lighting of Colson '297 comprises lamps (109) in the interior of a cabinet (3). The doors (19) have a transparent window (23). The electric lighting provides illumination to help a user locate stored items (Col. 6, lines 57-68). The Action has not shown any reason or motivation to combine, or explained how or why the electric lighting of Colson '297 would be placed with a locking arrangement as alleged,



especially since the illumination by interior lamps (109) are apparently already seen through the transparent windows (23). Any attempt to dramatically change the structural arrangement of Colson '297 would go directly against the implicit teaching of the Colson '297 reference and would destroy the reference. That is, the alleged modification to Colson '297 would destroy the disclosed utility or operability of the Colson '297 teaching, especially the disclosed use of the lamps (109) placed in the cabinet (3) to provide the illumination in the cabinet to find an item. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, it would not have been obvious to have provided Colson '297 with a visual indicator in the manner recited.

Furthermore, claim 46 specifically recites that the visual indicator of the lock provides an indication that a door is enabled to be opened in the manner recited. It is not seen where Colson '297 teaches that the electric lighting (109) provides a visual indication of a condition of a lock showing that a door is enabled to be opened. Colson '297 teaches merely that the electric lighting (109) provides illumination. Thus, Colson '297 does not disclose or suggest a visual indicator for providing an indication that a door is enabled to be opened in the manner recited. Any attempt to modify Colson '297 to include a lock comprising a visual indicator to provide an indication that a door is enabled to be opened is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is impermissible. It follows that it would not have been obvious to have modified Colson '297 in the manner alleged.

Furthermore, claim 46 recites that “the visual indicator provides an indication responsive to the at least one signal that the door is enabled to be opened.” From claim 45, the “signal” is from a computer to change the lock from a locked to an unlocked condition. Colson ‘297 does not disclose or suggest that a visual indicator is responsive to a signal (from a computer) to change a lock from a locked to an unlocked condition. Thus, Colson ‘297 does not teach or suggest the subject matter recited in claim 46. It follows that it would not have been obvious to have modified Colson ‘297 in the manner alleged.

It is respectfully submitted that the rejection on the basis of Colson ‘297 should be withdrawn as it fails to establish that all the features recited in Appellants’ claims are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

### **The Pending Claims Are Not Obvious Over Lavigne In View of Aten**

Claims 1 and 3 were rejected under 35 U.S.C. § 103(a) as obvious over Lavigne in view of Aten. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants’ claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants’ invention. The features recited in Appellants’ claims patentably distinguish over the applied references.

### **Claims 1 and 3**

As previously discussed, claims 1 and 3 recite numerous features and relationships that are not found in Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. Appellants' remarks, concerning the anticipation of claims 1 and 3 by the Lavigne reference, are herein incorporated by reference.

The rejection of Lavigne combined with Aten does not specifically cite any features in Aten that are necessary to overcome the deficiencies of the Lavigne reference alone. Nor is there any teaching, suggestion or motivation in any cited art to produce Appellants' claimed features and relationships. Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. It is therefore respectfully submitted that this rejection should be withdrawn.

The only discussion in the Action concerning the combination with Aten that mentions any features recited in any of the pending claims, might concern claim 26, which relates to a permanent magnet referred to in the rejection, although this claim is not mentioned. Nevertheless, the alleged permanent magnet feature is not recited in claims 1 or 3. The Action is silent as to why Aten was applied against claims 1 or 3. The Action is silent as to how Aten relates to claims 1 or 3. Nor has the Action explained how the teachings of Aten could have been used to modify Lavigne to teach the recited features and relationships of claims 1 and 3.

The Action does not state in any way that is reasonably understandable by Appellants, where the elements recited in Appellants' claims are allegedly found in the cited art. Nor is there

any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellants. For this reason it is respectfully submitted that the Action fails to establish a prima facie case of obviousness against any of the claims and the rejection should be withdrawn.

Because the Action fails to apply the references to the claims, Appellants have been required to speculate as to possible rationales for the rejections. Appellants have reviewed the references cited and have determined that the cited references, taken individually or as a whole, clearly do not teach or suggest the invention recited in Appellants' claims. Therefore, claims 1 and 3 would not have been obvious to one having ordinary skill in the art.

Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claims are allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections have been overcome.

**The Pending Claims Are Not Obvious Over Colson '450 In View of Lavigne**

Claims 1-3 were rejected under 35 U.S.C. § 103(a) as obvious over Colson '450 in view of Lavigne. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

As previously discussed, claim 1 recites numerous features and relationships that are not found in Colson '450. Appellants' remarks, concerning the rejection of claim 1 based upon the Colson '450 reference, are herein incorporated by reference.

As previously discussed, claims 1-3 recite numerous features and relationships that are not found in Lavigne. Appellants' remarks, concerning the rejections of claims 1-3 based upon the Lavigne reference, are herein incorporated by reference.

The discussion in the rejection suggests that it may be addressing to some extent only the features recited in claim 2. This is because claim 2 is the only claim currently under consideration that discusses a "visual indicator."

The Action is silent as to why Lavigne was applied against claims 1 or 3. The Action is silent as to how Lavigne relates to claims 1 or 3. Nor has the Action explained how the teachings of Lavigne could have been used to modify Colson '450 to teach the recited features and relationships of claims 1 and 3.

The Action does not state in any way that is reasonably understandable by Appellants, where the elements recited in Appellants' claims 1 and 3 are allegedly found in the cited art. Nor is there any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellants. For this reason it is respectfully

submitted that the Action fails to establish a prima facie case of obviousness against any of the claims and the rejection should be withdrawn.

Because the Action fails to apply the references to the claims, Appellants have been required to speculate as to possible rationales for the rejections. Appellants have reviewed the references cited and have determined that the cited references, taken individually or as a whole, clearly do not teach or suggest the invention recited in Appellants' claims. Therefore, the claims would not have been obvious to one having ordinary skill in the art.

#### **Claim 1**

Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. The rejection on the basis of Colson '450 and Lavigne does not overcome the deficiencies of the rejections already discussed, which rejections assert for example that pending claim 1 is anticipated by these same references. Thus, as the Colson '450 and Lavigne references do not disclose all the elements of the claims (nor any teaching, suggestion, or motivation to produce the claimed combination), the rejection is further respectfully submitted to be improper on this basis.

The rejection on the basis of Colson '450 in view of Lavigne is further respectfully submitted to be improper because it fails to indicate specifically to which claims the asserted features of these references are applied. Rather the rejection leaves the Appellants to speculate as to the assertions being made. As the rejection presented does not comply with the Manual of Patent Examining Procedure in providing Appellants with adequate notice as to which claims the

features of the cited art are being applied, it is further respectfully submitted that the rejection is improper and should be withdrawn.

As previously discussed, Colson '450 does not disclose the capability of inputting identification data through an input device, corresponding to the data representative of an authorized user stored in a data store. Colson '450 does not use data representative of an authorized user. Colson '450 does not use data representative of an authorized user stored in a data store. Nothing in Colson '450 discloses or suggests that a user inputs identification data to an input device, and that the input data is compared to data representative of authorized users.

As previously discussed, nothing in Lavigne compares identification information input by a user to authorized user data stored in a data store. The memory on the Lavigne carrier only holds information corresponding to the person having possession of the carrier at any given time through their respective keys (Col. 8, lines 26-29). However, there is no disclosure or suggestion in Lavigne that the information input concerning the person having custody of the carrier is compared to a listing of "authorized users." Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest the recited features which are absent in Colson '450.

Furthermore, Colson '450 does not disclose that in response to a user inputting identification data corresponding to an authorized user, the computer enables the user to input data corresponding to a medical item through the input device. Colson '450 does not disclose enabling the input of data corresponding to a medical item, in response to the user inputted identification data corresponding to data for an authorized user.

Nothing in Lavigne discloses or suggests that a user is enabled to input indicia corresponding to a medical item responsive to the input of information corresponding to an authorized user in a database. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest the recited features which are absent in Colson '450.

Neither Colson '450 nor Lavigne taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claims are allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

## **Claim 2**

Claim 2 depends from claim 1 and further recites that "the lock module further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the signal that the door is enabled to be opened."

The rejection on the basis of Colson '450 and Lavigne admits that Colson '450 alone does not disclose a visual indicator located on a lock. The Action then goes on to state (without any citation to any teaching, suggestion, or motivation in the cited art) that it would be "obvious to substitute location of the visual indicator to the lock as a matter of design choice because proximate placement of a visual indicator is sufficient to indicate to the user the location of the compartment(s) and the status of the lock corresponds with the compartment access commands



from the computer (Col. 6, lines 47-56; Col. 7, lines 10-35).” Appellants respectfully submit that this assertion is not sufficient to reject the pending claim.

The Action admits that Colson '450 does not disclose a visual indicator located on a lock. It follows that Colson '450 does not disclose a visual indicator that provides an indication responsive to a signal from a computer that causes the lock to be changed from a locked condition to an unlocked condition.

As previously discussed Lavigne also does not disclose or suggest these features. Appellants’ remarks, concerning the rejection of claim 2 based on the Lavigne reference, are herein incorporated by reference.

The Action alleges (in paragraph 11) that Lavigne shows a visual indicator proximate the lock (Col. 11, lines 3-43). The Action alleges that it would have been obvious to place a visual indicator on the Lavigne’s lock. Hence, the Action inherently admits that Lavigne lacks a lock module comprising a visual indicator. Appellants respectfully submit that in Lavigne, it is the control module (31) which has a visual indicator (LEDs 75) (Col. 5, lines 54-57), not a lock module. Hence, Lavigne cannot overcome the deficiencies of Colson ‘450 as it does not disclose or suggest the recited features which are admittedly absent in Colson ‘450.

Furthermore, claim 2 specifically recites that the visual indicator provides an indication that the door is enabled to be opened. In Lavigne, the indicator lights (LEDs 75) only indicate a temperature condition (Col. 11, lines 25-43), not the door’s locked or unlocked condition. Hence, Lavigne cannot overcome the deficiencies of Colson ‘450 as it does not disclose or suggest the recited features which are absent in Colson ‘450.

Furthermore, claim 2 recites that “the visual indicator provides an indication responsive to the signal that the door is enabled to be opened.” From claim 1, the “signal” is from a computer to change the lock module from a locked to an unlocked condition. Lavigne does not disclose or suggest that a visual indicator is responsive to a signal (from a computer) to change a lock module from a locked to an unlocked condition. Contrarily, as previously discussed, Lavigne, at best, only discloses changing a locking solenoid (139) from a normally unlocked condition, to a locked condition. Thus, Lavigne actually teaches away from the subject matter recited in claim 2. Hence, Lavigne cannot overcome the deficiencies of Colson ‘450 as it does not disclose or suggest the recited features which are absent in Colson ‘450.

It is respectfully submitted that the rejection on the basis of Colson ‘450 in view of Lavigne should be withdrawn as it fails to establish that all the features recited in Appellants’ claims are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

### **Claim 3**

Claim 3 depends from claim 1 and further recites that “the lock module further comprises a door sensor, wherein the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock module to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.”

The Action admits that Colson ‘450 does not disclose “a door sensor; door is operative to generate an open signal responsive to the door opening.” The Action then alleges that Lavigne

“discloses a door sensor with the door operative to generate an open signal responsive to the door opening.” The Action further alleges that it would have been “obvious to use a sensor to detect the opening of the door as a means of saving power and recording removal of the item as taught by Colson” ‘450.

The Action admits that Colson ‘450 does not disclose a “door sensor” or that “the door sensor is operative to generate an open signal responsive to opening the door.” It follows that Colson ‘450 lacks a lock module comprising a door sensor. It further follows that Colson ‘450 lacks that a “computer is operative responsive to the open signal to change the lock module to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.”

The Lavigne system senses the opening of a door to record an event in memory. However, the sensing of the door opening in no way causes a lock to change its condition so that when the door of the Lavigne carrier is thereafter closed, it is held closed and locked. The portion of the Lavigne reference cited against claim 3 (in paragraph 5) in the Action (Col. 6, lines 47-56) only indicates that sensors are included for sensing when drawers of the Lavigne carrier have been opened. Nothing in Lavigne discloses or suggests that in response to sensing the opening of a drawer, a lock condition is changed so that the door will be locked the next time it is closed, as is specifically recited in claim 3.

Hence, Lavigne cannot overcome the deficiencies of Colson ‘450 as it does not disclose or suggest the recited features which are admittedly absent in Colson ‘450.

It is respectfully submitted that the rejection on the basis of Colson '450 in view of Lavigne should be withdrawn as it fails to establish that all the features recited in Appellants' claims are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

**The Pending Claims Are Not Obvious Over Blechl In View of Weinberger**

Claims 45-47 were rejected under 35 U.S.C. § 103(a) as obvious over Blechl in view of Weinberger. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

Before a claim may be rejected on the basis of obviousness the Patent Office must show that all the recited features of the claim are known in the prior art. MPEP § 2142. In addition to showing that all the features and relationships are known in prior art references, the Patent Office further bears the burden of showing in the cited art a specific teaching, suggestion or motivation to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 U.S.P.Q. 2d 1593 (Fed. Cir. 1987). The teaching, suggestion or motivation to combine features in prior art references must be *clearly* and *particularly* identified in such prior art to support a rejection on the basis of obviousness. *In re Dembiczak*, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999).

The rejection based on the alleged combination of Blechl and Weinberger is legally improper under this standard for several reasons. First, the Action does not state which features in the claims are absent in Blechl that require the addition of Weinberger's teachings. Secondly, no specific feature of Weinberger is identified as contributing to the features asserted to be added into Blechl. The discussion of Weinberger in the Action does not point to any feature or any specific area of that disclosure which is asserted to be pertinent to the claims at issue. In addition there is no specific or particular teaching cited in either prior art reference that would cause one skilled in the art to produce the claimed invention. The only comments concerning Weinberger in the Action are as follows:

“It would have been obvious for Blechl to include a visual indicator as a part of a lock module because a visual signal can direct the user to the correct door/drawer as taught by Weinberger. It would have been obvious for Blechl to have the computer lock the door responsive to a sensor indicating door closure because locking the door can reduce unauthorized access as taught by Weinberger.”

Where does Weinberger teach a lock module with a visual signal that directs a user to a correct door/drawer? Where does Weinberger have a computer lock a door responsive to a sensor indicating a door closure? Where is there any specific teaching in Weinberger or Blechl to make the asserted combination?

The Manual of Patent Examining Procedure specifically requires that the Patent Office clearly and fully state any grounds for any rejection. MPEP § 707.07(d). It is respectfully submitted that the rejections fail to satisfy those requirements and should be withdrawn as legally improper.

#### **Claim 45**

Claim 45 is an independent claim which is specifically directed to a “system for providing medical items.” The claim specifically recites that “the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored.” The claim further recites that “responsive to a user inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the at least one input device, and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition.” Neither Blechl nor Weinberger taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim.

Blechl does not disclose or suggest a computer in operative connection with a data store, which data store includes data for a plurality of authorized users. Indeed the express description of Blechl's operation makes clear that Blechl does not include a data store which holds information for a plurality of authorized users. Instead Blechl has each user insert a magnetic

card which is read by a card reader. Blechl's device then requires the user to input a personal identification number (PIN). The input PIN is then compared to the card which is read and if there is a match, access is allowed (Col. 4, lines 23-34; Col. 9, lines 13-19). As a result Blechl makes it very clear that it has no computer connected to a data store holding data for a plurality of authorized users.

Blechl uses a card containing data (corresponding to the user's PIN) for a single user, not a data store holding data for a plurality of authorized users. Blechl simply compares the card data with the PIN inputted by a single user to determine if the system may be operated by that particular user. The inputted PIN is only compared to the data on the card. The inputted card data and PIN is not compared via a computer to the card data and PINs of a plurality of authorized users stored in a data store. Furthermore, the routines from which the user is authorized to select are determined by the routine information programmed into the card. Blechl, at best, uses microprocessing means to compare the card data (for a single user) to the inputted PIN. Therefore, Blechl does not disclose a computer in operative connection with a data store, wherein the data store includes user data representative of a plurality of authorized users. Furthermore, there is no teaching, suggestion, or motivation in Blechl for comparing inputted user identification data, to data in a data store containing data for a plurality of authorized users.

Weinberger does not disclose or suggest a computer in operative connection with a data store, wherein the data store includes user data representative of a plurality of authorized users. Weinberger cannot overcome the deficiencies of Blechl as it does not disclose or suggest the recited features which are absent in Blechl.

Blechl suggests that an IC card or a magnetic card need not be used alone to initiate drug dispensing from the device, but that additional input means (e.g., a PIN) may be used in conjunction with the card (Col. 4, lines 20-34; Col. 9, lines 13-19). For example, a personal identification number (numerical password) may be used with the card so that if the data on the card matches the input numerical password, drugs can be dispensed (Col. 9, lines 13-19). Blechl also suggests that more secure operation control means may be used in conjunction with the card when extremely sensitive drugs are involved (Col. 4, lines 34-36). The more secure means may involve finger print or retina scan (Col. 4, lines 34-36), or passwords, fingerprints, voice identification, or hand prints (Col. 8, lines 60-68). The data for the additional operation control means, like the PIN, is stored on the card. Blechl provides no other embodiments for enabling operation of his device other than by using a card with data stored thereon. Furthermore, Blechl provides no disclosure or suggestion of using a computer in operative connection with a data store, wherein the data store includes user data representative of a plurality of authorized users.

Furthermore, claim 45 specifically recites that “the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored.” That is, the recited data store includes data representative of (1) a plurality of authorized users, (2) a plurality of medical items, and (3) storage locations in which the medical items are stored. Appellants respectively submit that Blechl’s card does not include data representative of (1), (2), or (3). It follows that Blechl’s card does not include data representative of (1), (2), and (3). Nor does



Blechl disclose or suggest that a “computer is in operative connection with a data store” which includes data representative of (1), (2), and (3).

Weinberger does not disclose or suggest a data store including data representative of a plurality of authorized users, a plurality of medical items, and storage locations in which the medical items are stored. Hence, Weinberger cannot overcome the deficiencies of Blechl as it does not disclose or suggest the recited features which are absent in Blechl.

Furthermore, claim 45 specifically recites “a user interface in operative connection with the computer, wherein the interface includes at least one input device.” Claim 45 further recites that a user is capable of “inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store.” Claim 45 further recites that a user is capable of inputting “item indicia corresponding to a medical item through the at least one input device.” That is, the user is capable of inputting both “identification data” and “item indicia” “through the at least one input device.” In Blechl the user identification unit (247) is specifically designed to be separate from the medication input unit (248). Note Col. 8, lines 45-51, and Figures 12 and 19.

Claim 45 further recites that responsive to input of data corresponding to one of the plurality of authorized users stored in the data store, the computer of the recited invention enables a user to input item indicia corresponding to a medical item through at least one input device. The Action asserts that Blechl has an input device at Col. 4, lines 39-50. This portion of Blechl does not stand for the proposition asserted in the Action. Instead it talks about a mechanic or pharmacist accessing the interior of Blechl’s device. It is discussed that such a mechanic or

pharmacist can gain access by inputting a matching card and PIN and allowing a door (38) to be opened through a touch screen (30) and operation of a processor. However, there is no disclosure that the touch screen is only enabled to receive inputs in response to prior receipt of a matching card and PIN. There is certainly no disclosure or suggestion that the mechanic or pharmacist inputs through the touch screen, indicia corresponding to a particular medical item. Indeed there is no particular medical item that is accessed by opening the door (38). As Blechl does not disclose these features and relationships which are expressly recited in claim 45, claim 45 is further allowable on this basis.

Weinberger does not disclose or suggest that responsive to input of data corresponding to one of the plurality of authorized users stored in a data store, a computer enables a user to input item indicia corresponding to a medical item through at least one input device. Hence, Weinberger cannot overcome the deficiencies of Blechl as it does not disclose or suggest the recited features which are absent in Blechl.

In the Action only the features of Blechl are cited as allegedly pertinent to claim 45. No specific features of Weinberger have been cited with regard to claim 45. However, because no 35 U.S.C. § 102 type of rejection was presented against claim 45 based on Blechl, the Action inherently admits that Blechl does not anticipate claim 45. As the Action cites no source of other features, or any teaching, suggestion or motivation in the relevant art to modify Blechl so as to produce the invention specifically recited in claim 45, the Action does not present a valid 35 U.S.C. § 103(a) rejection, and claim 45 is allowable.

Neither Blechl nor Weinberger taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome. It is respectfully submitted that the claims that depend from claim 45 (claims 46-47) are also allowable.

#### **Claim 46**

Claim 46 depends from claim 45 and further recites that the lock comprises a visual indicator which provides an indication responsive to at least one signal that the door is enabled to be opened. The Action cites Blechl (Col. 7, lines 13-34) as disclosing such a feature. Appellants respectfully submit that this portion of Blechl does not disclose or suggest such a feature.

The cited portion of Blechl refers to a wire (124) shown in Figure 6 which extends through a pair of apertures in a cartridge. The wire is broken to release the medication containers stored in the cartridge. The unbroken condition of the wire indicates that none of the medication containers have been removed.

This breakable wire (124) of Blechl in no way provides a visual indication in response to at least one signal from a computer as specifically recited in claim 46. Furthermore, the wire (124) of Blechl does not provide an indication that a door is enabled to be opened as specifically recited in claim 46.

The Action apparently asserts that Weinberger includes a lock module which provides a visual signal that directs a user to a correct door/drawer. However, no portion of Weinberger is cited for this teaching. Nor is it seen where Weinberger discloses such alleged features. Further, no teaching, suggestion, or motivation for combining features of Weinberger with features of Blechl is presented in the Action.

Neither Blechl nor Weinberger taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. It is respectfully submitted that claim 46 is further allowable for these reasons.

#### **Claim 47**

Claim 47 depends from claim 45 and further recites that the lock comprises a door sensor. The door sensor is operative to generate an open signal responsive to opening the door. Claim 47 further recites that the computer operates responsive to the open signal to change the lock to the locked condition. As a result when the door is next returned to a closed condition, the door is held closed.

The Action cites Col. 13, lines 20-30 of Blechl as disclosing this feature. However, Blechl ends at Col. 13, line 27. In addition the cited portions of Blechl are Blechl's claims 17-19 which teach, disclose, or suggest nothing concerning the features specifically recited in claim 47. Thus, no portion of Blechl is cited for this teaching. Nor is it seen where Blechl discloses such alleged features.

The Action asserts that Weinberger includes a computer to lock a door responsive to a sensor indicating door closure. However, no particular element or portion of the Weinberger is

cited in the Action as disclosing this particular feature. Furthermore, no specific teaching, suggestion, or motivation is cited in either Weinberger or Blechl for combining features so as to produce what is expressly recited in claim 47.

Claim 47 specifically recites that “the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.”

In Blechl the user manually closes the door/drawer. The “latch mechanism secures the drawer and communicates to the microprocessing means that the drawer has been closed” (Col. 9, lines 56-64). That is, at best, a closed door signal is generated, not an open door signal as recited.

Blechl’s computer is not operative responsive to an open signal. Nor does it appear that Blechl’s computer is even operative responsive to a closed signal. It follows that Blechl’s computer is not responsive to an open signal to change a lock to a locked condition. Contrarily, in Blechl the microprocessor is notified only after the door/drawer has been closed and apparently after the door/drawer has already been locked (secured). Hence, there is no need for the computer to change the lock to the locked condition.

The claim further recites that the computer changes the lock to the locked condition so that “when the door is next returned to a closed condition the door is held therein.” That is, the computer places the lock in the locked condition prior to the door being returned to the closed condition. In Blechl “latch mechanism secures the drawer and communicates to the

microprocessing means that the drawer has been closed” (Col. 9, lines 56-64). That is, in Blechl’s system the door is first closed and secured then the microprocessing means is notified. Blechl does not teach or suggest, nor does Blechl appear capable of, the microprocessing means initiating a locked condition prior to the door being closed. Nor does Blechl teach or suggest the microprocessing means initiating a locked condition prior to the door being closed in response to the door being open.

The Action states that “It would have been obvious for Blechl to have the computer to lock the door responsive to a sensor indicating door closure because locking the door can reduce unauthorized access as taught by Weinberger.” It is noted that the Action refers to “a sensor indicating door closure.” However, claim 47 clearly recites that the “door sensor is operative to generate an open signal responsive to opening the door.” It is respectfully submitted that the Action’s starting basis for obviousness is completely opposite to the recited claim language. Thus, even if the references were combined in the manner alleged, the combination would still not meet the claimed invention.

As noted above Blechl lacks many of the recited features and relationships. Weinberger also does not disclose or suggest that a “door sensor is operative to generate an open signal responsive to opening the door”, nor that a “computer is operative responsive to the open signal to change the lock to the locked condition”, nor that “when the door is next returned to a closed condition the door is held therein.” No portion of Weinberger is cited for these recited features and relationships. Nor is it seen where Weinberger discloses such alleged features and relationships. Further, no teaching, suggestion, or motivation for combining features of

Weinberger with features of Blechl is presented in the Action. Hence, Weinberger cannot overcome the deficiencies of Blechl as it does not disclose or suggest the recited features and relationships which are absent in Blechl.

Neither Blechl nor Weinberger taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. It is respectfully submitted that claim 47 is further allowable for these reasons.

**Appellants' Claims Should Be Allowed Because the Action Has Not Shown That the Features and Relationships Claimed Are Known in the Prior Art**

It is respectfully submitted that all the pending claims should be allowed because the Action has failed to recite with the legally required specificity, where the recited elements are shown in the prior art. In the case of all obviousness rejections, the Action has failed to specify a teaching, suggestion, or motivation found in the prior art for purposes of making the claimed combination.

It is respectfully submitted that the citation in the Action to blocks of text without any reference to the particular feature or teaching which is alleged to correspond to the recited claim elements, does not provide in a legally sufficient basis for rejecting the claims. Further, as discussed in detail in relation to the rejections which were not overcome by swearing behind the cited references, the portions of the references cited in the Office Action generally do not stand for the propositions asserted in the Action and often have no bearing whatsoever to the features specifically recited.

Appellants respectfully submit that in view of the plainly legally insufficient basis for rejecting Appellants' claims, that all of the claims should be allowed.

**The Claims Also Patentably Distinguish Over The References That Were Sworn Behind**

Because Lavigne, Colson '450, Pearson '232, and Higham do not constitute prior art in the instant application (involving at least claims 24 and 45), Appellants find it unnecessary to discuss in this Brief the detailed reasons why these references (and their involved rejections) do not anticipate or render obvious the features and relationships recited in the claims 24-26 and 45-47 against which they were cited in the Action. Nevertheless, Appellants will also show that the appealed claims patentably distinguish over these references and the following rejections:

Claims 24-25 as rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne.

Claim 24 as rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson '450.

Claim 45 as rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Pearson '232.

Claims 24-26 as rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne.

Claims 24-26 as rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Lavigne in view of Aten.

Claims 24-25 as rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Colson '450 in view of Lavigne.



### **The Pending Claims Are Not Anticipated By Lavigne**

Claims 24-25 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Lavigne.

This rejection is respectfully traversed. Appellants traverse this rejection on the grounds that the Lavigne reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claims patentably distinguish over the Lavigne reference.

#### **Claim 24**

Claim 24 is an independent claim which is specifically directed to a "system for providing medical items." The claim specifically recites that "the lock module is operative responsive to a signal from the computer to change the lock module from a locked to an unlocked condition." The claim further recites that "the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition."

Appellants respectfully submit that Lavigne does not disclose the recited features and relationships. The Action alleges that Lavigne discloses a "lock responsive to the computer (col. 11 L 39-43)"; "the computer operative to output a signal which changes the lock (col. 11, L 39-43; col. 8, L 59-62)"; and that the "computer is operative responsive to input of the item indicia to unlock the module (col. 8, L 24-30; col. 8 L 58-59)." The Appellants disagree.

As previously discussed, in Lavigne when the person in control of the carrier wishes to administer a drug, they can open the door (21) or open a drawer (37, 41, 43), remove the desired drug from the carrier, and then administer the drug to the patient (Col. 14, lines 34-45). The

operator also records the administration of the drug by entering a code into memory. The controller in the Lavigne carrier monitors the temperature of the temperature sensitive medications held therein. If the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). This alerts the user to the fact that the drugs in the carrier may have been subject to spoilage due to an out of temperature condition. An out of temperature condition (e.g., locked door 21) typically can only be cleared by the use of a pharmacist key (Col. 12, lines 60-63) which also resets the controls (Col. 11, lines 3-12). However, a user is enabled to open the door (21) through a mechanical override if the user needs to obtain access to the medications even when there has been an out of temperature condition (Col. 12, line 64-Col. 13, line 2).

Appellants respectfully submit that Lavigne does not disclose using a computer to change a lock module from a locked to an unlocked condition. Lavigne, at best, is only capable of locking the door (21). The door is unlocked by use of a pharmacist key. Hence, Lavigne does not disclose using a computer to unlock a lock module.

Appellants respectfully submit that Lavigne also does not disclose a computer operative responsive to an input of an item indicia to output a signal changing the lock module to the unlocked condition. Lavigne does not disclose using a computer, which responds to inputted data, to output a signal to change a lock module from a locked condition to an unlocked condition. In Lavigne, the door (21) is unlocked by use of a pharmacist key, not by a computer. It follows that Lavigne's door (21) is not unlocked by a computer in response to inputted data.

Furthermore, nothing in Lavigne compares identification information input by a user to data stored in a data store. The memory on the Lavigne carrier holds information corresponding to the person having possession of the carrier at any given time. However there is no disclosure or suggestion in Lavigne that the information input concerning the person having custody of the carrier is compared to a listing of “authorized users.”

Claim 24 further specifically recites that responsive to the input of identification data corresponding to an authorized user, a user is enabled to input data corresponding to a medical item. Again, nothing in Lavigne discloses or suggests that a user is enabled to input indicia corresponding to a medical item responsive to the input of information corresponding to an authorized user in a database.

Additionally claim 24 specifically recites that responsive to the input of the medical item indicia (which activity is enabled when the identification data input corresponds to an authorized user), the computer is caused to output a signal, which signal changes the lock module controlling the door of the housing structure to an unlocked condition. Nothing in Lavigne discloses or suggests controlling a lock to open the door (21) in response to either medical item indicia or identification data corresponding to an authorized user. As Lavigne makes amply clear, the door (21) of his medication carrier is always unlocked except in circumstances when an out of range temperature condition has been sensed, in which case the door will lock because a temperature violation which could have damaged the medications has occurred (see Col. 11, lines 37-43).

It is respectfully submitted that claim 24 recites numerous features and relationships which are neither disclosed nor suggested in Lavigne. Thus not only is Lavigne not prior art, Lavigne also does not anticipate the claim. For these reasons it is respectfully submitted that claim 24 as well as all the claims that depend therefrom should be allowed.

#### **Claim 25**

Claim 25 depends from claim 24 and recites that “the lock module further includes a door sensor in operative connection with the door and the computer.” Claim 25 further recites that a “latching device is operative to hold the lock module in the unlocked position responsive to the signal.” Claim 25 further recites that “the computer is operative to cause the output of a further signal, wherein the further signal changes the lock module to a locked condition and thereafter the latching device holds the lock module in the locked condition.” Claim 25 further recites that “the computer is operative to cause the further signal to be output responsive to the earlier of at least one of the door sensor sensing opening of the door and the passage of a time delay period after output of the signal without the door sensor sensing opening of the door.”

Appellants respectfully submit that Lavigne does not disclose a computer operative responsive to a sensor sensing opening of a door to change a lock module to a locked condition. Nor does Lavigne disclose a computer operative responsive to a time delay period to change a lock module to a locked condition. In Lavigne, if the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). That is, the controller of Lavigne operates the locking solenoid (139) based on sensing temperature conditions, not on sensing

whether the door was opened or the passage of a time delay period. In Lavigne the door (21) may be opened many times without initiating the locking solenoid (139) (Col. 9, lines 7-10; Col. 14, lines 34-37; Col. 12, lines 15-18).

The Lavigne system senses the opening of a door to record an event in memory. However, Lavigne does not disclose or suggest that the sensing of a door opening or the passage of a time delay period causes a lock to be held in a locked condition.

The portion of the Lavigne reference cited against claim 25 in the Action (Col. 6, lines 47-56; Col. 7, lines 10-35) only indicates that sensors are included for sensing when drawers of the Lavigne carrier have been opened (Col. 6, lines 47-56) and locking solenoid (139) operation (Col. 7, lines 10-35). Nothing in Lavigne discloses or suggests that in response to sensing the opening of a drawer or the passage of a time delay period, a lock module is changed to a locked condition and held in the locked condition, as is specifically recited in claim 25.

Furthermore, claim 25 recites that “the computer is operative to cause the further signal to be output responsive to the earlier of at least one of the door sensor sensing opening of the door and the passage of a time delay period after output of the signal without the door sensor sensing opening of the door.” Lavigne does not disclose passage of a period of time measured after the output of the signal. Nor does Lavigne determine the earlier of either sensing the opening of the door or the passage of the time delay period.

Lavigne does not disclose each and every feature and relationship of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Hence, Appellants’ claim 25 patentably distinguishes over the Lavigne reference. Therefore, it is

respectfully submitted that the 35 U.S.C. § 102(b) rejection should be further withdrawn for these reasons.

### **The Pending Claims Are Not Anticipated By Colson '450**

Claim 24 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Colson '450.

This rejection is respectfully traversed. Colson '450 is not prior art. Appellants additionally traverse this rejection on the grounds that the Colson '450 reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claim patentably distinguish over the Colson '450 reference.

#### **Claim 24**

Claim 24 is an independent claim which is specifically directed to a "system for providing medical items." The claim specifically recites that "the data store includes user data representative of a plurality of authorized users." The claim further recites that "responsive to a user inputting identification data through the input device of the interface corresponding to the data representative of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to the one medical item through the input device." The claim further recites that "the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition."

Appellants respectfully submit that Colson '450 does not disclose the recited features and relationships. The Action alleges that Colson '450 discloses that a "data store includes user data

representative of a plurality of authorized users (col. 5, L 17-29; Fig. 1. #21).” The Appellants disagree. The referenced section is not pertinent to a data store having user data representative of a plurality of authorized users. In the cited section of Colson ‘450, the user inputs “information concerning the particular patient and information as to the person entering the data” (Col. 5, lines 17-19). The patient’s record (reflecting the inputted patient information and the user, e.g., the particular nurse) may be simultaneously and automatically updated (Col. 5, lines 20-29). Information may even be processed in real-time (Col. 3, lines 45-57). However, there is no indication that Colson ‘450 is concerned with the user being an authorized user.

Appellants respectfully submit that Colson ‘450 does not disclose the capability of inputting identification data through an input device corresponding to data representative of an authorized user stored in a data store. Colson ‘450 does not use data representative of an authorized user. Colson ‘450 does not use data representative of an authorized user stored in a data store.

Furthermore, Colson ‘450 does not disclose that in response to a user inputting identification data corresponding to an authorized user, the computer enables the user to input data corresponding to a medical item through the input device. Colson ‘450 does not disclose the capability of checking whether a user is an authorized user. Colson ‘450 does not disclose enabling the input of data corresponding to a medical item, in response to the user inputted identification data corresponding to data for an authorized user.

Additionally as previously discussed, the user in Colson ‘450 inputs “information concerning the particular patient and information as to the person entering the data” (Col. 5, lines

17-19). Hence, it appears that the user in Colson '450 actually inputs the "information concerning the particular patient" prior to inputting the "information as to the person entering the data." This is further evidence that Colson '450 is not concerned with the user being an authorized user. Additionally, the use of the inputted user information appears to be only for the patient's record, e.g., the nurse that supplied the medication.

Again, there is no disclosure or suggestion whatsoever that Colson '450 has a computer in connection with a data store with authorized user data, data representative of medical items, and data corresponding to storage locations where medical items are stored. Further, nothing in Colson '450 discloses or suggests that a user inputs identification data to an input device, and that the input data is compared to data representative of authorized users. As Colson '450 expressly indicates (Col. 5, lines 17-29), a user of the Colson '450 device inputs information concerning a patient and information on the person entering the data, and the door opens. There is no teaching, suggestion, or motivation in Colson '450 that a comparison is made of input user identification data to data concerning a plurality of authorized users.

Claim 24 also specifically recites that the computer enables a user to input indicia corresponding to a medical item through an input device. As Colson '450 expressly indicates (Col. 5, lines 17-29), no item indicia corresponding to a medical item is input into the Colson '450 computer. Colson '450 only inputs information concerning a patient and the person entering the data, which then causes a door of Colson '450 to open. Nothing in Colson '450 discloses or suggests the feature of a computer enabling a user to input indicia corresponding to a medical item through an input device, which is specifically recited in claim 24.



Claim 24 further recites that the computer is operative responsive to input of the item indicia corresponding to a medical item, to output a signal changing a lock from a locked to an unlocked condition, enabling opening a door of the housing structure. Again Colson '450 does not disclose or suggest the input of indicia corresponding to a medical item through an input device, nor having such input data cause a computer to unlock a lock.

It is respectfully submitted that claim 24 recites numerous features and relationships which are neither disclosed nor suggested in Colson '450. Thus, not only is Colson '450 not prior art, it also does not anticipate the claim. For these reasons it is respectfully submitted that claim 24 as well as all the claims that depend therefrom should be allowed.

### **The Pending Claims Are Not Anticipated By Pearson '232**

Claim 45 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Pearson '232.

This rejection is respectfully traversed. Pearson '232 is not prior art. Appellants also traverse this rejection on the grounds that the Pearson '232 reference does not contain all the elements of the claimed invention arranged in the manner recited in the claim. The features recited in Appellants' claim 45 patentably distinguish over the Pearson '232 reference.

### **Claim 45**

Claim 45 is an independent claim which is specifically directed to a "system for providing medical items." The claim specifically recites that "the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized

users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored.” The claim further recites that “responsive to a user inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the at least one input device, and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition.”

It is respectfully submitted that claim 45 recites features and relationships that are plainly not found in Pearson ‘232. In contrast to the elements recited in claim 45, the system in Pearson ‘232 does not disclose a computer with a data store having stored user information corresponding to “authorized users.” Further, Pearson ‘232 does not have a computer that operates responsive to the input of identification data that corresponds to one of the authorized users, to enable input of indicia which identifies a medical item. Pearson ‘232 operates to dispense medication in the manner expressly indicated therein (e.g., Col. 4, line 60 to Col. 5, line 5). First a password is entered (via a keyboard; Col. 3, lines 13-15) by a nurse to authorize use of the dispenser. Next the nurse enters patient identification information. Next the nurse verifies that the screen displayed by the computer corresponds to the correct patient. Then the computer unlocks each container (8) or drawer (10) holding medication that the patient is scheduled to receive at that time.

During an unscheduled request (e.g., an emergency) the dispensing of medication may also occur (Col. 6, lines 6-23). However, the acting nurse has to provide their name and an

explanation for the reason of the request. The computer is able to record all pertinent information, including the medications dispensed, the amount of medication, the identity of the patient, the time dispensed, the name of the nurse, and the explanation.

Pearson '232 does not disclose or suggest a computer in operative connection with a data store, which data store includes data for a plurality of authorized users. The device of Pearson '232 requires the user to input a password. The password appears to be a multi-user password which enables several different persons to access the dispenser (computer) using the same password. Thus, the arrangement of the dispenser (computer) of Pearson '232 is similar to a personal computer that enables access to plural users while requiring only a single password. That is, only a single password is required to access the dispenser of Pearson '232. Therefore, any nurse that has been authorized to know the current password may access the medication dispenser.

Pearson '232 does not disclose or suggest that a computer operates in response to determining that the inputted user identification data corresponds to one of a plurality of different authorized users. Pearson '232 does not disclose or suggest in any manner that a plurality of different passwords are required. Nor does Pearson '232 disclose or suggest that a plurality of different passwords are required corresponding to different authorized users. Nor does Pearson '232 disclose or suggest that a plurality of different passwords are stored in a data store, where the passwords reflect data representative of a plurality of authorized users. Pearson '232 does not disclose or suggest data corresponding to a plurality of authorized users stored in a data store. Nor does Pearson '232 disclose or suggest a computer in operative connection with the data

store. Nor does Pearson '232 disclose or suggest comparing (corresponding) inputted identification data with that of a plurality of authorized users' data. That is, in Pearson '232 there is no disclosure or suggestion of comparing an input password to a plurality of authorized passwords in a data store.

Furthermore, claim 45 specifically recites that "the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored." The Action has not indicated, nor is it seen, where Pearson '232 discloses a data store including data representative of a plurality of "authorized users", a plurality of "medical items", and "storage locations" in which the medical items are stored. Nor has the Action indicated, nor is it seen, where Pearson '232 discloses a computer in operative connection with a data store including data representative of a plurality of authorized users, a plurality of medical items, and storage locations in which the medical items are stored.

Furthermore, there is no disclosure in Pearson '232 of the feature that a computer operates in response to determining that the inputted user data corresponds to one of a plurality of authorized users, to then enable input of indicia corresponding to a medical item. Pearson '232 does not disclose the relationship, as specifically recited in claim 45, that the computer operates to enable the input of item indicia corresponding to a medical item responsive to receipt of identifying data corresponding to data for an authorized user among a plurality of authorized users for whom data is stored, and the computer then operating responsive to the item indicia to

generate a signal changing the condition of the lock to an open condition. Additionally, as previously discussed, Pearson '232 fails to disclose or suggest that a "data store includes user data representative of a plurality of authorized users."

It is respectfully submitted that claim 45 recites numerous features and relationships which are neither disclosed nor suggested in Pearson '232. Thus, not only is Pearson '232 not prior art, it also does not anticipate the claim. Furthermore, even if it were somehow possible for Pearson '232 to be entitled to the filing date of Pearson '029, Pearson '029 also does not disclose or suggest the recited features and relationships recited in claim 45. For these reasons it is respectfully submitted that claim 45 should be allowed.

### **The Pending Claims Are Not Obvious Over Lavigne**

Claims 24-26 were rejected under 35 U.S.C. § 103(a) as obvious over Lavigne. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied reference.

### **Claims 24 and 25**

As previously discussed, Lavigne is not prior art against the invention recited in claim 24. Claims 24 and 25 also recite numerous features and relationships that are not found in Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every

one of the features recited in the claims is at least known in the prior art. MPEP § 2142. The rejection on the basis of Lavigne alone does not overcome the deficiencies of the rejections already discussed, which rejections assert that the pending claims 24 and 25 are anticipated by the same reference. Thus, as the reference does not disclose or suggest all the elements of the claims (nor any teaching, suggestion, or motivation to produce the claimed combination), the rejection is further respectfully submitted to be improper. Appellants' remarks, concerning the anticipation of claims 24 and 25 by the Lavigne reference, are herein incorporated by reference.

#### **Claim 26**

Claim 26 depends from claim 25 and further recites that "the latching device includes a permanent magnet latching solenoid."

Appellants respectfully wish to point out the deficiency in the Action in regard to their request for a showing that the use of permanent magnet solenoids were known in the prior art of medical item dispensing systems, and for a specific citation to some teaching, suggestion, or motivation to include such a device in the recited combinations. In a prior response, Appellants challenged the assertion that an "official notice" could be taken that use of permanent magnets in solenoids is well known because such construction "averts the need for plural windings." In response to the traverse of the "official notice" rejection, the Patent Office in the Action cited the abstracts in Keskin, Nemoto, and Tabata. However, none of these patents have to do with the relevant art of medical item dispensing systems in the manner recited. No teaching, suggestion, or motivation in the relevant art was cited to include features of these patents in connection with a medical item dispensing system. None of these patents show the alleged advantage of averting

the need for plural windings, and in fact do not have such advantage. Finally, the citation in the Action to the abstract of Keskin does not appear to even discuss the use of a permanent magnet for any purpose.

Appellants respectfully submit that in view of the plainly legally insufficient basis for rejecting Appellants' claim, that the claim should be allowed.

Appellants respectfully submit that Lavigne does not disclose a latching device including "a permanent magnet latching solenoid." Nor does Lavigne disclose or suggest all the features and relationships (nor any teaching, suggestion, or motivation to produce the claimed combination) of claims 24 and 25 from which claim 26 depends. Therefore, the rejection is further respectfully submitted to be improper on this basis.

It is respectfully submitted that the rejection on the basis of Lavigne should be withdrawn as Lavigne is not prior art, and the rejection fails to establish that all the features and relationships recited in Appellants' claim are shown in the cited art, and further fails to show that there is any teaching, suggestion, or motivation in the cited art for producing the claimed invention.

**The Pending Claims Are Not Obvious Over Lavigne In View of Aten**

Claims 24-26 were rejected under 35 U.S.C. § 103(a) as obvious over Lavigne in view of Aten. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Lavigne is not prior art and that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and

because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

### **Claims 24 and 25**

As previously discussed, Lavigne does not constitute prior art against at least claim 24. Claims 24 and 25 recite numerous features and relationships that are not found in Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. Appellants' remarks, concerning the anticipation of claims 24 and 25 by the Lavigne reference, are herein incorporated by reference.

The rejection of Lavigne combined with Aten does not specifically cite any features in Aten that are necessary to overcome the deficiencies of the Lavigne reference alone. Nor is there any teaching, suggestion, or motivation in any cited art to produce Appellants' claimed features and relationships. Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. It is therefore respectfully submitted that this rejection should be withdrawn.

The only discussion based on the combination with Aten that discusses any features recited in any of the pending claims 24-26 might concern claim 26, which relates to a permanent magnet referred to in the rejection, although this claim is not mentioned. Nevertheless, the alleged permanent magnet feature is not recited in claims 24 or 25. The Action is silent as to why Aten was applied against claims 24 or 25. The Action is silent as to how Aten relates to



claims 24 or 25. Nor has the Action explained how the teachings of Aten could have been used to modify Lavigne to teach the recited features and relationships of claims 24 or 25.

The Action does not state in any way that is reasonably understandable by Appellants, where the elements recited in Appellants' claims are allegedly found in the cited art. Nor is there any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellants. For this reason it is respectfully submitted that the Action fails to establish a prima facie case of obviousness against any of the claims and the rejection should be withdrawn.

Because the Action fails to apply the references to the claims, Appellants have been required to speculate as to possible rationales for the rejections. Appellants have reviewed the references cited and have determined that the cited references, taken individually or as a whole, clearly do not teach or suggest the invention recited in Appellants' claim. Therefore, the claim would not have been obvious to one having ordinary skill in the art.

Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, and because Lavigne is not prior art, it is respectfully submitted that the claims are allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections have been overcome.

### **Claim 26**

Claim 26 depends from claim 25 which depends from claim 24. Claim 26 further recites that “the latching device includes a permanent magnet latching solenoid.”

The Action alleges that it would have been obvious to make the dispenser of Lavigne “with a solenoid having a permanent magnet because a construction averts the need for plural windings as taught by Aten et al. (Col. 9 L 1-30).” Hence, the Action inherently admits that Lavigne lacks a latching device including a permanent magnet latching solenoid.

Appellants disagree that Aten discloses or suggest a latching device in the manner recited. Nor does Aten at Col. 9, lines 1-30 teach to have a solenoid with a permanent magnet construction to avert the need for plural windings, as alleged in the Action.

The rejection of Lavigne combined with Aten does not specifically cite any features in Aten that are necessary to overcome the deficiencies of the Lavigne reference alone. Nor is there any teaching, suggestion, or motivation in Lavigne combined with Aten to produce Appellants’ claimed features and relationships.

Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants’ invention, it is respectfully submitted that the claim 26 is further allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

### **The Pending Claims Are Not Obvious Over Colson '450 In View of Lavigne**

Claims 24-25 were rejected under 35 U.S.C. § 103(a) as obvious over Colson '450 in view of Lavigne. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that neither of these references is prior art against at least independent claim 24. Appellants' claims also recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

#### **Claim 24**

As previously discussed, Lavigne and Colson '450 are each not prior art against claim 24. Claim 24 also recites numerous features and relationships that are not found in either Colson '450 or Lavigne. Before a valid obviousness rejection may be presented it must be established that each and every one of the features recited in the claims is at least known in the prior art. MPEP § 2142. Appellants' remarks, concerning the anticipation of claim 24 by the Colson '450 reference and by the Lavigne reference, are herein incorporated by reference. As previously discussed neither Colson '450 nor Lavigne disclose or suggest the features and relationships recited in claim 24. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest all of the recited features and relationships which are not found in Colson '450. It follows that the combination of Colson '450 and Lavigne also would not produce the invention recited in claim 24.

In the rejection of Colson '450 combined with Lavigne the Action does not specifically cite any features in Lavigne that are necessary to overcome the deficiencies of the Colson '450 reference alone. Nor is there any teaching, suggestion, or motivation in any cited art to produce Appellants' claimed features and relationships. Neither Colson '450 nor Lavigne taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. It is therefore respectfully submitted that this rejection should be withdrawn.

The only discussion based on the combination with Lavigne that discusses any features recited in any of the pending claims 24-25 might concern claim 25, which relates to a door sensor referred to in the rejection, although this claim is not mentioned. Nevertheless, the alleged door sensor feature is not recited in claim 24. The Action is silent as to why Lavigne was applied against claim 24. The Action is silent as to how Lavigne relates to claim 24. Nor has the Action explained how the teachings of Lavigne could have been used to modify Colson '450 to teach the recited features and relationships of claim 24.

The Action does not state in any way that is reasonably understandable by Appellants, where the elements recited in Appellants' claim are allegedly found in the cited art. Nor is there any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellants. For this reason it is respectfully submitted that the Action fails to establish a prima facie case of obviousness against any of the claims and the rejection should be withdrawn.

Because the Action fails to apply the references to the claim, Appellants have been required to speculate as to possible rationales for the rejections. Appellants have reviewed the

references cited and have determined that the cited references, taken individually or as a whole, clearly do not teach or suggest the invention recited in Appellants' claim. Therefore, the claim would not have been obvious to one having ordinary skill in the art.

Neither Lavigne nor Aten taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As both cited references are not prior art, and as nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

#### **Claim 25**

Claim 25 depends from claim 24 and recites that "the lock module further includes a door sensor in operative connection with the door and the computer." Claim 25 further recites that a "latching device is operative to hold the lock module in the unlocked position responsive to the signal." Claim 25 further recites that "the computer is operative to cause the output of a further signal, wherein the further signal changes the lock module to a locked condition and thereafter the latching device holds the lock module in the locked condition." Claim 25 further recites that "the computer is operative to cause the further signal to be output responsive to the earlier of at least one of the door sensor sensing opening of the door and the passage of a time delay period after output of the signal without the door sensor sensing opening of the door."

The Action admits that Colson '450 does not disclose "a door sensor; door is operative to generate an open signal responsive to the door opening." Appellants respectfully submit that Colson '450 lacks many more of the recited features and relationships. For example, Colson '450 does not use data representative of an authorized user. Colson '450 also does not use data representative of an authorized user stored in a data store. Furthermore, Colson '450 does not disclose the capability of checking whether a user is an authorized user. Colson '450 also does not disclose enabling the input of data corresponding to a medical item, in response to the user inputted identification data corresponding to an authorized user data. There is no disclosure or suggestion whatsoever in Colson '450 of a computer in connection with a data store with authorized user data, data representative of medical items, and data corresponding to storage locations where medical items are stored. Also, Colson '450 does not disclose or suggest the input of indicia corresponding to a medical item through an input device, nor having such input data cause a computer to unlock a lock. Furthermore, Colson '450 does not disclose passage of a period of time measured after the output of the signal. Nor does Colson '450 determine the earlier of either sensing the opening of a door or the passage of the time delay period.

The recited features of which Lavigne lacks in relation to claim 25 have been previously discussed. Appellants' remarks, concerning the alleged anticipation of claim 25 by the Lavigne reference, are herein incorporated by reference. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest all of the recited features and relationships which are not found in Colson '450.

The Action alleges that Lavigne “discloses a door sensor with the door operative to generate an open signal responsive to the door opening.” The Action also alleges that it “would have been obvious to use a sensor to detect the opening of the door as a means of saving power and recording removal of the item as taught by Colson” '450. Appellants disagree.

The Action admits that Colson '450 does not disclose the features and relationships of a door sensor in the manner recited. Appellants respectfully submit that Lavigne also does not disclose the features and relationships of a door sensor in the manner recited. Lavigne does not disclose a computer operative responsive to a sensor sensing opening of a door to change a lock module to a locked condition. Nor does Lavigne disclose the passage of a period of time measured after the output of the signal. Nor does Colson '450 determine the earlier of either sensing the opening of a door or the passage of the time delay period. Nor does Lavigne disclose a computer operative responsive to such determination to change a lock module to a locked condition. Hence, Lavigne cannot overcome the deficiencies of Colson '450 as it does not disclose or suggest all of the recited features and relationships which are not found in Colson '450.

In Lavigne, if the temperature goes out of range, the controller of Lavigne operates a locking solenoid (139) which operates to lock the door (21) to hold it in a closed position (Col. 11, lines 37-43; Col. 7, lines 24-26). That is, the controller of Lavigne operates the locking solenoid (139) based on sensing temperature conditions, not on sensing whether the door was opened or the passage of a time delay period. In Lavigne the door (21) may be opened many

times without initiating the locking solenoid (139) (Col. 9, lines 7-10; Col. 14, lines 34-37; Col. 12, lines 15-18).

The Lavigne system senses the opening of a door to record an event in memory. However, neither Colson '450 nor Lavigne disclose or suggest that the sensing of a door opening or the passage of a time delay period causes a lock to be held in a locked condition. Nothing in Colson '450 or Lavigne discloses or suggests that in response to sensing the opening of a drawer or the passage of a time delay period, a lock module is changed to a locked condition and held in the locked condition, as is specifically recited in claim 25.

Neither Colson '450 nor Lavigne taken alone or in combination disclose or suggest the features and relationships that are specifically recited in the claim. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claim is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

### **The Advisory Action**

The Advisory Action briefly refers to *res judicata* in relation to claim 45. However, MPEP § 707.07(g) clearly states that where a major technical rejection (such as *res judicata*) is proper, "it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression." It is respectfully submitted that a full development



of reasons has not been provided to Appellants, as is required. Hence, the Advisory Action's brief mention of *res judicata* constitutes piecemeal examination and a legally insufficient basis for rejection.

Furthermore, it is respectfully submitted that if the Patent Office is in fact applying a *res judicata* type of rejection, then this type of rejection was first applied in the Advisory Action. Thus, because the *res judicata* type of rejection was first applied after the Final rejection, it constitutes an improper new ground of rejection.

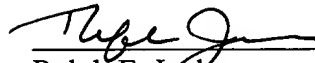
### **Other Comments**

Appellants' remarks in the amendments filed May 23, 2000 and September 27, 2000 are herein incorporated by reference.

### **CONCLUSION**

As explained above, many of the rejections are improper as they are not based on references which constitute prior art. Further, each of the pending claims specifically recite features, relationships, or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellants' invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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## APPENDIX

### CLAIMS

1. A system for providing medical items comprising:

a computer, wherein the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored;

a user interface in operative connection with the computer, wherein the interface includes an input device;

a refrigerator, wherein a storage location for at least one medical item is stored in an interior area of the refrigerator, the refrigerator including a door, wherein access to the interior area is controlled by opening and closing the door;

a lock module operatively attached to the refrigerator, wherein the lock module is in operative connection with the computer, and wherein the lock module is operative responsive to a signal from the computer to change the lock module from a locked to an unlocked condition, wherein in the locked condition the

refrigerator is prevented from being opened and in the unlocked condition the door is enabled to be opened;

wherein responsive to a user inputting identification data through the input device of the interface corresponding to the data representative of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to the one medical item through the input device, and wherein the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition.

2. The system according to claim 1 and wherein the lock module further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the signal that the door is enabled to be opened .

3. The system according to claim 1 and wherein the lock module further comprises a door sensor, wherein the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock module to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.

24. A system for providing medical items comprising:

a computer, wherein the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored;

a user interface in operative connection with the computer, wherein the interface includes an input device;

a preexisting housing structure, wherein a storage location for at least one medical item is stored in an interior area of the housing structure, the housing structure including a door, wherein access to the interior area is controlled by opening and closing the door.

a lock module mounted on an exterior surface of the housing structure, wherein the lock module is in operative connection with the computer, and wherein the lock module is operative responsive to a signal from the computer to change the lock module from a locked to an unlocked condition, wherein in the locked condition the door is prevented from being opened and in the unlocked condition the door is enabled to be opened;

wherein responsive to a user inputting identification data through the input device of the interface corresponding to the data representative of an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to the one medical item through the input device, and wherein the computer is operative responsive to input of the item indicia to output the signal changing the lock module to the unlocked condition.

25. The system according to claim 24 wherein the lock module further includes a door sensor in operative connection with the door and the computer, and a latching device wherein the latching device is operative to selectively maintain the lock module in the locked and unlocked conditions, wherein the latching device is operative to hold the lock module in the unlocked position responsive to the signal, and thereafter the computer is operative to cause the output of a further signal, wherein the further signal changes the lock module to a locked condition and thereafter the latching device holds the lock module in the locked condition, and wherein the computer is operative to cause the further signal to be output responsive to the earlier of at least one of the door sensor sensing opening of the door and the passage of a time delay period after output of the signal without the door sensor sensing opening of the door.

26. The system according to claim 25 wherein the latching device includes a permanent magnet latching solenoid.

45. A system for providing medical items comprising:

a computer, wherein the computer is in operative connection with the data store, wherein the data store includes user data representative of a plurality of authorized users, item data representative of a plurality of medical items, and location data representative of storage locations in which the medical items are stored;

a user interface in operative connection with the computer, wherein the interface includes at least one input device;

a housing, wherein a storage location for at least one medical item is located in an interior area of the housing, the housing including a door, wherein access to the storage location is controlled by opening and closing the door;

a lock in operative connection with the housing, wherein the lock is in operative connection with the computer, and wherein the lock is operative responsive to at least one signal from the computer to change the lock from a locked to an unlocked condition, wherein in the locked condition the door is prevented from being opened and in the unlocked condition the door is enabled to be opened;

wherein responsive to a user inputting through the at least one input device identification data corresponding to data for an authorized user stored in the data store, the computer enables the user to input item indicia corresponding to a medical item through the at least one input device, and wherein the computer is operative responsive to input of the item indicia to output the at least one signal changing the lock to the unlocked condition.

46. The system according to claim 45 and wherein the lock further comprises a visual indicator, and wherein the visual indicator provides an indication responsive to the at least one signal that the door is enabled to be opened.

47. The system according to claim 45 and wherein the lock further comprises a door sensor, wherein the door sensor is operative to generate an open signal responsive to opening the door, and wherein the computer is operative responsive to the open signal to change the lock to the locked condition, wherein when the door is next returned to a closed condition the door is held therein.